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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,127	12/06/2000	Donald J. Berk	BERK 100	9205

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EXAMINER
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STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/04/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,127

Applicant(s)

BERK, DONALD J.

Examiner

Aaron Strange

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 02122001. 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because the boxes in Fig 1 are not labeled, the handwritten numbering in Figure 3 is difficult to read, Figure 5 is difficult to read, particularly element 38, and several of the documents contain handwritten numberings which are very faint. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2,3,5,7,8,9,12,13,15,17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In regard to claims 2 and 12, the term "Internet" on line 1 of each claim, by virtue of being capitalized, implies that the applicant is referring to "the Internet". It is well known in the art that the Internet is a very specific internet and being used in the phrase "an Internet" renders the scope of the claims indefinite.

In further regard to claim 2, the first computer system cannot be an internet or the Internet, since internets are networks and are not programmable. Claim 1 specifically states that the first computer system is programmable.

5. In regard to claims 2,3,7,8 and 9, the term "meta-code" is not clearly defined in the specification, and it is not clear what a meta-code comprises. "Meta-code" is used on page 6, line 17 to refer to a specific example of the code disclosed earlier, but is not limited as such in the claims. For the purpose of applying prior art, "meta-code" is given the same definition of the less restrictive code disclosed in the summary of invention.

6. All claims not specifically addressed are rejected by virtue of their dependency from the above claims.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is merely a non-functional descriptive arrangement of printed matter. See *In re Miller*, 418 F.2d 1392, 164USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1,2,3,4,5,7,8,9,11,12,13,15,17,18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Durst et al. (US 5,933,829).
11. In regard to claim 1, Durst et al. disclose a method for providing access to supplemental data for a printed publication, comprising: An electronic database including supplemental data for the printed publication (Col 2, lines 13-15) that is accessible from a first computer system (Col 2, lines 36-31); generating an index having a first parameter for identifying the page and a second parameter associated with the

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supplemental data and said first parameter for input into said computer system (Col 4, lines 59-64); and providing instructions for said first computer system for retrieving said supplemental data in response to receiving said second parameter (Col 2, lines 54-58).

12. In regard to claim 2, Durst et al. further disclose that the first computer system retrieves the supplemental data via the Internet (Col 2, line 64 to Col 3, line 1) and the second parameter is a meta-code for input (Col 2, lines 47-53).

13. In regard to claim 3, Durst et al. further disclose a client computer for receiving said meta-code and generating and directing a file transfer request word to a server (Col 2, lines 47-53 and Col 2, line 64 to Col 3, line 1). At least one client computer and at least one server computer are inherent components of any internet, including the Internet.

14. In regard to claim 4, Durst et al. further disclose that the file location pointer comprises a URL (Col 3, lines 8-10).

15. In regard to claim 5, Durst et al. disclose that the encoded file location pointer comprises a network address associated with at least one server computer and a file identifier correlated to a first location in said database (Col 3, lines 5-9).

16. In regard to claim 7, Durst et al. further disclose encoding in said index an encryption key associated with a source identifier data string, said encryption key suitable for receipt by said client computer to encrypt information specific to a user associated with said client computer, said encrypted user information suitable for assemblage within a computer file transfer request word and transmission to said server computer (Col 11, claim 14).

17. In regard to claim 8, Durst et al. further disclose that the server computer utilizes a source identifier data string to access a lookup table to determine a decryption key associated with said encryption key, and decrypting said encrypted user information (Col 11, claim 17).

18. In regard to claim 9, Durst et al. further disclose that the lookup table is stored remotely on a secondary server computer (Col 11, claim 19).

19. In regard to claim 11, Durst et al. disclose a system comprising: A first label having indicia associated therewith for ascribing said first label to selected contents of a page of said book and further comprising a contents code (Col 4, lines 50-57); an electronic database having a contents code field and a contents field including supplemental information (Col 2, lines 13-15); a computer system for receiving said contents code and retrieving said supplemental information (Col 2, line 64 to Col 3, line 1). The contents code field is an inherent part of the database containing supplemental information since a means for correlating the contents code provided by the client and the supplemental information is needed for the database to function correctly.

20. In regard to claim 12, Durst et al. further disclose that the first computer system retrieves the supplemental data via the Internet and the second parameter comprises a file transfer request word (Col 2, line 64 to Col 3, line 1).

21. In regard to claim 13, Durst et al. further disclose that the file location pointer comprises a URL (Col 3, lines 8-10).

22. In regard to claim 15, Durst et al. further disclose a client computer for receiving said meta-code and generating and directing a file transfer request word to a server

(Col 2, lines 47-53 and Col 2, line 64 to Col 3, line 1). At least one client computer and at least one server computer are inherent components of any internet, including the Internet.

23. In regard to claim 17, Durst et al. further disclose encoding in said index an encryption key associated with a source identifier data string, said encryption key suitable for receipt by said client computer to encrypt information specific to a user associated with said client computer, said encrypted user information suitable for assemblage within a computer file transfer request word and transmission to said server computer (Col 11, claim 14).

24. In regard to claim 18, Durst et al. further disclose that the server computer utilizes a source identifier data string to access a lookup table to determine a decryption key associated with said encryption key, and decrypting said encrypted user information (Col 11, claim 17).

25. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Iggulden (US 5,954,515).

26. In regard to claim 20, Iggulden discloses one or more updateable locations in a printed publication, a plurality of codes (indicia) for locating the supplemental data that corresponds to the updateable locations (Col 2, lines 40-56), and data processor means programmed for receiving at least one of said codes and responsively providing said supplemental information (Col 3, lines 35-56). An index to identify updateable locations is inherent in the system disclosed by Iggulden as the locations must be identified in order to be marked with the indicia disclosed by Iggulden.



***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable Durst et al. (US 5,933,829) in view of Grant (US 4,972,615).

29. In regard to claim 6, Durst et al. disclose an index but does not disclose the use of an adhesive label or specifically disclose the use of a character string as the second parameter.

Grant discloses the printing of indicia on adhesive labels rather than on the pages of the book since adhesive labels can easily be applied to a book one already possesses (Col 2, lines 44-45). Durst et al. disclose an index consisting of a machine-readable code (Col 2, lines 15-17), but does not disclose the specific embodiment of a character string. However, a character string is easily read by a machine using optical character recognition technologies, and would be an obvious alternative to barcode Durst et al. disclose in the preferred embodiment. The use of a character string would also allow the user to manually input the code using a keyboard rather than a machine scanner.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Durst et al. to print the

index on labels as disclosed by Grant rather than on the pages of the book to allow additional indicia to be provided or existing indicia to be changed as needed to reflect new supplemental information in an existing book. It would also be obvious to use a character string as the second parameter since it is easily read by a machine and would allow the user to use a keyboard as an alternative input means.

30. In regard to claim 16, while the system disclosed by Durst et al. shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the labels are adhesive or that the document type is a textbook.

While the reference remains silent on the specific use of a textbook, it is clear that the type of document used has no special relevance to the invention. Textbooks are old and well known in the art and would have benefited from the invention disclosed by Durst et al.

Grant discloses the printing of indicia on adhesive labels rather than on the pages of the book since adhesive labels can easily be applied to a book one already possesses (Col 2, lines 44-45). Durst et al. disclose an index consisting of a machine-readable code (Col 2, lines 15-17), but does not disclose the specific embodiment of a character string. However, a character string is easily read by a machine using optical character recognition technologies, and would be an obvious alternative to barcode Durst et al. disclose in the preferred embodiment. The use of a character string would also allow the user to manually input the code using a keyboard rather than a machine scanner.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Durst et al. to print the index on labels as disclosed by Grant rather than on the pages of the book to allow additional indicia to be provided or existing indicia to be changed as needed to reflect new supplemental information in an existing book. It would have been further obvious to apply the invention of Durst et al. to textbooks in order to provide supplemental information to textbook readers in addition to readers of any other type of document.

31. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst et al. (US 5,933,829) in view of ISBN.org.

32. In regard to claim 10, Durst et al. disclose providing to the server process a list of user identifiers (demographics) (Col 4, line 63 and Col 3, lines 54-57), a URL (Col 4, line 62 and claim 7), the address of at least a first location in said database (file location pointer) (Col 4, line 62), at least one label code parameter (Col 4, line 64), generating said index (Col 4, lines 51-58), and establishing an electronic information database (Col 2, lines 13-15). A source identifier is also disclosed, but the specific use of an ISBN is not disclosed in the reference.

However, an ISBN is a widely known standard method of uniquely identifying a book or edition (ISBN.org), and would be the preferred method of uniquely identifying a book having an ISBN in a database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an ISBN as the source identifier for books, since

ISBNs are the standard method of applying a serial number to a book for unique identification. Use of an ISBN allows the book to be uniquely identified, and differentiates even between different editions of the same title.

33. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst et al. (US 5,933,829).

34. In regard to claim 14, Durst et al. disclose the use of a machine readable code that is printed on a document along with text and graphics (Col4, lines 50-55), but does not specifically disclose a textbook as a document type.

While the reference remains silent on the specific use of a textbook, it is clear that the type of document used has no special relevance to the invention. Textbooks are old and well known in the art and would have benefited from the invention disclosed by Durst et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the invention of Durst et al. to textbooks in order to provide supplemental information to textbook readers in addition to readers of any other type of document.

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 703-305-8878. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**

ANS 9/24/2004